

Remarks

Status of Claims:

Claims 1, 4, and 8-20 are rejected. Claim 1 is amended. Claims 1, 4, 8-20 remain.

Support for the amendment to claim 1 is found in the drawings as filed. No new matter is added.

102 Rejections:

Claim 1 is rejected as anticipated by US 6,758,824 (Miller). It is respectfully urged that this rejection is improper for at least the following reasons.

Claim 1, as amended, recites a portion of the proximal needle segment extends distally of the proximal end of the distal needle segment. It is respectfully urged that this is not taught or suggested by Miller.

It is also respectfully urged that Miller does not teach

a distal needle segment formed of a non-metallic, first material that does not interfere with MRI imaging of a portion of the distal needle segment associated with a tissue receiving port; and

a proximal needle segment disposed proximally of the tissue receiving port, the proximal needle segment formed at least in part of a metallic, second material different from said first material

The Examiner states that:

“Miller et al. suggest the proximal needle segment is formed of a metallic, non-magnetic material” and refers to col 6, lines 50-67 of Miller, and col 7, lines 1-2.

It is respectfully urged that this is not a correct characterization of the portions of Miller cited by the Examiner. Column 6, lines 50-67 and col 7, lines 1-2 of Miller states that in a specific embodiment, both the outer cannula and inner cutter of Miller are formed of a metal, and that a trocar tip can be stainless steel.

It is respectfully urged that Miller does not teach that a proximal portion of the outer cannula 15 be formed of metal, with a distal portion associated with the tissue receiving port be formed of a non-metallic material.

The Examiner is respectfully requested to provide the specific portion of Miller where Miller teaches each of the limitations of Claim 1, or withdraw the rejection.

The Examiner also states:

“The distal needle segment of the Miller et al device includes a tissue receiving port(43) and is made of non-metallic material....” Citing col 8, lines 22-60 of Miller.

As explained in the previous response, this is also not a correct characterization of the cited portion of Miller. Instead, Column 8, lines 22-60 of Miller state:

“In fact, with the exception of outer cannula 15, trocar tip 16 and inner cannula 17, every component of the biopsy apparatus in accordance with the present invention can be formed of a non-metallic material....” (underlining added)

Accordingly, the portion of Miller cited by the Examiner does not support the rejection, but instead, teaches that the outer cannula 15 of Miller is formed of metal. This teaching that all the components except the outer cannula 15, trocar tip 16, and inner cannula 17 be formed of a non metallic material cannot be fairly used by the Examiner as anticipating the subject matter of Claim 1, but instead teachings away from the subject matter of claim 1.

Further, it is not seen how Miller teaches or suggests a distinction regarding a proximal portion of the outer cannula and a distal portion of the outer cannula 15, and the Examiner is respectfully requested to point out what are the proximal and distal portions of the cannula 15 to which the Examiner refer, or withdraw the rejection.

In view of the above, the Examiner is respectfully urged to withdraw the rejection of Claim 1 and all claims depending therefrom.

Claim 16:

Similarly, with respect to Claim 16, Miller does not teach or suggest either:

- a distal needle segment comprising a tissue receiving port communicating with distal cutter lumen portion and formed of a non-metallic material, or
- a proximal needle segment formed at least in part of metal, where the metal is proximally spaced at least about 0.5 inch from a proximal edge of the tissue receiving port.

The Examiner is respectfully requested to specifically point out where in Miller there is such a teaching, or withdraw the rejection.

Claim 19:

Claim 19 recites, among other things,

a distal needle segment formed of a non-metallic material and having a lateral tissue receiving port communicating with a distal cutter lumen segment, wherein the distal needle segment has a proximal end; and

a metallic proximal needle segment disposed proximally of the tissue receiving port, wherein the metallic proximal needle segment provides a proximal cutter lumen segment communicating with the distal cutter lumen segment, wherein the proximal needle segment has a distal end;

wherein the distal end of the proximal needle segment is positioned distally of the proximal end of the distal needle segment.

The Examiner is respectfully urged to explain specifically where Miller teaches a distal needle segment formed of a non-metallic material, a metallic proximal needle segment, and wherein the distal end of the proximal needle segment is positioned distally of the proximal end of the distal needle segment.

Obviousness Rejections:

It is respectfully urged that each of the obviousness rejections is improper for at least the reason that each obviousness rejection is based upon the Examiner's incorrect application of Miller, as explained above.

Based on the foregoing, all pending claims are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and an early notice of allowance.

Respectfully submitted,

/Gerry Gressel/
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